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Application Number 10/627,440

Filing Date 07/25/2003

First Named Inventor Thomas S. BELCHER

Art Unit 3712

Examiner Name Vishu K. MENDIRATTA

Attorney Docket Number 03-0431.01

ENCLOSURES (Check all that apply)

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Lanier Ford Shaver & Payne P.C.		
Signature			
Printed name	George P. Kobler		
Date	January 3, 2006	Reg. No.	46,837

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Attorney Docket No.: 03-0431.01
Inventors: Belcher, et al



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

In re Application of: Thomas Seth Belcher, et
al

Group Art Unit: 3711

Serial No.: 10/627,440

Filed: July 25, 2003

Examiner: Vishnu Mendiratta

Title: *A Portable, Adaptable Drawing
Surface for Strategy Games*

APPELLANT'S REPLY UNDER 37 C.F.R. 1.193

Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))

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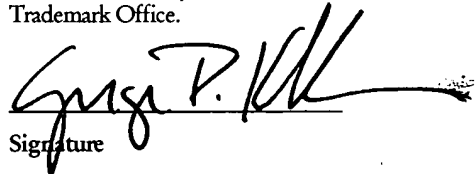
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Dear Sir:

Appellant hereby submits its Reply Brief under 37 C.F.R. § 1.193 in support of its appeal, notice of which was filed under 37 C.F.R. § 1.191 on June 13, 2005 and date stamped received by the USPTO on June 15, 2005.

Remarks

Examiner suggests that whether an article is proposed to be drawn upon would be the intended use of an apparatus, and would not further the apparatus in the claims. This is true if Applicant proposed such a use as a limitation in its claims without a corresponding structural element. However, in this context the proposed use of an article was submitted to indicate the reasoning behind the design and structural elements of an article disclosed in a prior patent reference. Specifically, if the game board taught by allegedly anticipating reference *Bassett* were intended to be drawn upon with a dry-erase marker, it would have disclosed an appropriate structural element to accommodate that use. Applicant still maintains that it does not. As such, Examiner erred in maintaining the rejection under Sec. 102 based upon *Bassett*.

Dry-erase markers are designed to be used on non-porous surfaces. The U.S. patents cited by Examiner in his answer support this. For example, U.S. Pat. No. 6,402,144 discloses “[i]t is understood that both sides of each card may include a coating suitable for use with dry erase markers such that other sets of indicia may be manipulated as desired by a user, for example, musical notes.” Col.5, 62- 65. And U.S. Pat. No. 5,741,561 teaches that for its invention, “[a]t least the top sheet of placemat 10 comprises a clear vinyl and preferably has a silicone coating which is double polished to allow easy wiping off of markers made with a dry erase marker. It should be appreciated that other conventional techniques or materials which allow the wiping of dry erase markers can be used.” Col.2, ll 32-37. The surface upon which it is intended that dry-erase markers are to be used must be specifically treated in order so that marks made with such markers may be easily erased. This is a structural element of the present claims that is not taught in any way by *Bassett*. Examiner’s response provides no evidence that all plastic materials are compatible with the use of dry-erase markers which is necessary in order to support a rejection under 35 U.S.C. Sec. 102.

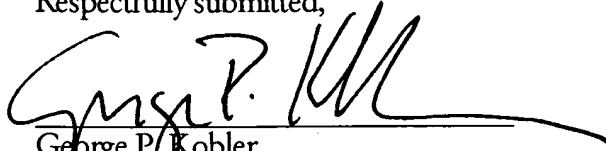
Examiner's response also fails to provide the required motivation for combining *Bassett* and the secondary reference, *Ward* (U.S. Pat. No. 4,060,246). In addressing motivation to combine, Examiner simply lists desirable features of plastic in general, and asserts that often players write notes or rules on game boards. However, to successfully show motivation to combine references in support of a rejection under either 35 U.S.C. Section 103, the Examiner must provide evidence; Examiner's conclusory statements are insufficient. See *In re Læ*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Examiner further asserts that "it remains a fact that (sic) Bassett board is 'substantially non-porous', and could be used with dry-erase marker." Indeed, Applicant concedes that dry-erase markers may be used to mark on a plastic board, or cardboard, or tissue, or human skin for that matter. Nowhere does *Bassett* disclose that marks made by dry-erase markers on a plastic board are easily erasable. Therefore, whether the board disclosed in *Bassett* is suitable for use with dry-erase markers is not a fact. Examiner's arguments still fail to provide the requisite motivation. Because the Examiner has not provided the motivation to combine the references, there is no prima facie case of obvious and the rejection under Sec. 103 should be withdrawn.

Last, first elements of Claims 1 and 11, as amended, require that each of the sides of the tiles comprising the present gameboard include means for interconnecting with like tiles. This element is likewise not disclosed in either *Bassett* or *Ward*. *Bassett* discloses tiles (or "segments") that have sides without means for interconnecting. This is because the board of *Bassett* is simply designed to stay in the same shape throughout its use. Examiner's arguments do not address this feature of Applicant's invention. The two references argued by examiner do not disclose this element or suggest it. Therefore, Claims 1 and 11, and their respective dependent claims are neither anticipated under Sec. 102, nor are they rendered obvious under Sec. 103.

Based upon the foregoing, Applicant respectfully submits that all of the rejections should be withdrawn and earnestly requests that the Board remand the case with instructions to

allow the case as amended.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "George P. Kobler", with a long horizontal flourish extending to the right.

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